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REMARKS

This amendment responds to the Office Action dated March 3, 2004. Claims 1, 11 and 23 have been amended to more clearly specify the claimed invention. The remaining claims remain unchanged from the original or previously amended versions.

CLAIMS 1-2 AND 4-23 ARE PATENTABLE OVER SULLIVAN ET AL. AND JAMBHEKAR ET AL.

The Examiner rejected claims 1-2 and 4-23 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,593,973 to Sullivan et al. [hereinafter "Sullivan et al."] in view of U.S. Patent No. 5,848,356 to Jambhekar et al. [hereinafter "Jambhekar et al."]. Essentially, the Examiner contends that Sullivan et al. discloses all of the elements of the claims at issue, except for an input device adapted to receive, to store an instruction corresponding to a graphic data and to transmit graphic data to a remote server." The Examiner then cites Jambhekar et al. as providing this missing teaching. Finally, the Examiner contends that it would have been obvious to one of ordinary skill in the art "to provide an input device in the device of [Sullivan et al.], in view of the teaching in the [sic] [Jambhekar et al.] because this would provide a user an easier way to compose and to transmit his message to others as taught by [Jambhekar et al.]." The Applicant respectfully disagrees with the Examiner's characterization of these references vis-à-vis the claims at issue.

A *prima facie* case of obviousness based on these two references cannot stand because even assuming *arguendo* that these references may be combined (in fact, they cannot be properly combined as shown below), any combination fails to result in the claimed inventions. For example, claim 1 includes the recitation "selectively transmitting said data corresponding to said at least one instruction from said remote server to said at least one display interface wherein said at least one display interface overlays said graphic on the received video broadcast displayed on said display device *to create a combined video and graphic so that both the graphic and the*

received broadcast video are simultaneously displayed on the display device." [emphasis supplied]. Similar recitations appear in the other independent claims.

First, Sullivan et al. fails to disclose overlaying a graphic upon a video image being displayed on a display device. In contrast, Sullivan et al. discloses a method for *replacing* a video signal with an alternate source during a transition from one video source to another video source. Sullivan et al. specifically teaches that such "overlaying" (which is in fact not overlaying but replacing) must occur during the transition period to take advantage of an otherwise blank screen caused by such a transition period. While Sullivan et al. states "overlaying" the video, in fact, Sullivan et al. merely replaces the video with another source during the transition period. Thus, Sullivan et al. does not overlay video from a broadcast source with a graphic generated from a user input device, as set forth in the claims at issue.

As mentioned by the Examiner, Jambhekar et al. fails to teach overlaying a graphic onto a video from a broadcast source. The Applicant concurs. Jambhekar et al. relates to mobile telephones and as such does not disclose a system in which a graphic can be integrated into a video being displayed on a television. In fact, Jambhekar et al. relates to the use of functional icons to represent information, but not to generate a graphic that is transmitted to a server for overlaying onto a video being displayed.

Therefore, the combination of these references (*i.e.*, Sullivan et al. and Jambhekar et al.) also fails to result in the invention set forth in the claims at issue. As these recitations are not included in Sullivan et al. or Jambhekar et al. (even assuming *arguendo* these references can be combined in the manner suggested by the Examiner), claims 1, 11 and 23, and those that depend therefrom, are therefore patentable over Sullivan et al. and Jambhekar et al., either taken alone or in the combination suggested by the Examiner.

Moreover, even assuming *arguendo* that Sullivan et al. discloses this missing teaching, Sullivan et al. cannot be combined with Jambhekar et al. to arrive at the claimed invention because it is improper to combine references where the references teach away from their combination. In re Grasselli, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). A prior art

reference must be considered in its entirety, *i.e.*, as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). In sum, Sullivan et al. teaches away overlaying graphics on a video because Sullivan et al. states one must insert an alternate video source (as opposed to a graphic) during a transition period – not just during any part of the video source. Thus, Sullivan et al. teaches that any replacement or "overlaying" must occur during a transition period. This teaches away from overlaying a graphic on the video to create a combined video and graphic because during a transition period no video is being displayed. As mentioned above, the present invention enables the overlaying of a graphic generated by a handheld user input device onto a video source so that the combined video (*i.e.*, not simply a blank screen) and graphic is displayed. As Sullivan teaches away from combining a graphic with a video during a non-transition period any combination that would purport to overlay video and graphics that would include Sullivan et al. is not proper. Reconsideration and withdrawal of the rejection of claims 1-2 and 4-23 is therefore respectfully requested.

CLAIM 3 IS PATENTABLE OVER SULLIVAN ET AL., JAMBHEKAR ET AL. AND DAILEY

The Examiner rejected claims 3 under 35 U.S.C. §103(a) as being unpatentable over Sullivan et al. in view of Jambhekar et al. and further in view of U.S Patent No. 5,642,350 to Dailey [hereinafter "Dailey"]. Essentially, the Examiner contends that the above combination of Sullivan et al. and Jambhekar et al. discloses all of the elements of the claims at issue, except "teaching a plurality of remote display interfaces arranged in a peer-to-peer network." The Examiner then cites Dailey as providing this missing teaching. Finally, the Examiner contends that it would have been obvious to one of ordinary skill in the art "to provide a plurality of remote display interfaces arranged in a peer-to-peer network in the device of Sullivan because this would permit every device on the network to initiate as well as receive messages from other

devices on the network, as taught by Dailey." The Applicant respectfully disagrees with the Examiner's characterization of these references vis-à-vis the claim at issue.

Dailey fails to teach a method by which a graphic can be overlain on a video image *to create a combined video and graphic so that both the graphic and the received broadcast video are simultaneously displayed on the display device*, as recited in claim 1 from which claim 3 ultimately depends. As these recitations are not included in Sullivan et al., Jambhekar et al. or Dailey (even assuming *arguendo* these references can be combined in the manner suggested by the Examiner), claim 3 is therefore patentable over Sullivan et al., Jambhekar et al. and Dailey, either taken alone or in any combination. Reconsideration and withdrawal of the rejection of claim 3 is therefore respectfully requested.

CONCLUSION

The Applicants respectfully submit this application is in condition for allowance and request issuance of a Notice of Allowability.

In the event the prosecution of this application can be efficiently advanced by a phone discussion, it is requested that the undersigned attorney be called at (703) 435-9390.

FEES

If additional amounts are due following the amendments made to the claims above, or for any other reason, it is respectfully requested that the PTO charge any deficiency or credit any overpayment to the

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deposit account of Mayer Fortkort & Williams PC, Deposit Account, #50-1047.

Respectfully submitted,

By _____ Date: June 3, 2004
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